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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,847	02/26/2002	Stephen L. Patrick	N883B	4835

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EXAMINER
RILEY, SHAWN

ART UNIT	PAPER NUMBER
2838	

Norman Friedland
Suite 400
11300 U. S. Highway One
North Palm Beach, FL 33408

DATE MAILED: 01/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Offic Action Summary	Application No. 10/081,847	Applicant(s) PATRICK ET AL.	
	Examiner Shawn Riley	Art Unit 2838	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *26 February 2002* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Specification Objection

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some **unclear, inexact** or verbose terms used in the specification are, as near as can be understood, the disclosure describing an apparatus and method which, *inter alia,*;

> 1) is intended to generate electricity by exploiting static energy from the magnetic flux of the permanent magnet and by the motionless generator's nature of being an open dissipative system, receiving, collecting, and dissipating energy from it environment, i.e., from the magnetic flux stored within the permanent magnet[1].
>
> 2) operates with a coefficient of over 3.[2]
>
> 3) generates the power required to drive the input coils (26 & 28) all within the right output coil (29) thus allowing additional loads.[3]

Each of these statements are unclear and inexact.

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1 See, e.g., page 18 lines 22 through page 19 line 1.
2 See, e.g., page 17 lines 22-23.
3 See, e.g., page 18 lines 11-17.

UNCLEAR AND INEXACT FOR THE FOLLOWING REASONS;

In response to applicants' statement

The 1st law of thermodynamics;

> One way of putting it says that a fixed amount of mechanical work always gives rise to the equivalent amount of heat. Thus energy can be converted from work into heat, but it can neither be created nor destroyed. There are more complex formulations of the first law but all eventually arrive at the answer that the universe is constant. To create new matter (or, equivalently, energy) from nothing is not in the power of mankind. Energy is conserved. This first law of thermodynamics cannot be evaded.

The 2nd law of thermodynamics;

> The reverse (heat into physical energy, for example) cannot be fully accomplished without outside help or without an inevitable loss of energy in the form of irretrievable heat.

By generating electricity by exploiting static energy from the magnetic flux of the permanent magnet and by the motionless generator's nature of being an open dissipative system, receiving, collecting, and dissipating energy from it environment, i.e., from the magnetic flux stored within the permanent magnet applicants' have violated the first and second law.

By operating with a coefficient of performance over 3 applicants have violated at least the first law.

And finally by generating the power required to drive the input coils (26 & 28) all within the right output coil (29) thus allowing additional loads.[4]

Claim Rejections - 35 USC § 101

The following is a quotation of 35 U.S.C. § 101:

> "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

Claims 1-14 are rejected under 35 U.S.C. § 101 because the device will not operate as an electrical energy generating system and, therefore, lacks utility as an energy producing means.

As explained in the objections to the specification above, no net energy gain is possible in the operation of the device. The device will not produce any more energy than what is already present at the input. Statements in the specification regarding the large amount of power generated by the device[5] seem to indicate that the applicant believes the device will produce more electrical power than that available and will supply energy out when no energy is input. This is not possible. Any additional energy "created" would violate the laws of energy conservation. As stated by the Patent Office Board of Appeals, *Newman v. Quigg* 681 F.Supp 16, at 18, 5 U.S.P.Q2d 1880 (1988),

Specifically, the applicant **is required to demonstrate** how the magnetic flux stored within the permanent magnet is sufficient to contribute usable electrical energy to the device and how the device then generates more power than what is available in the permanent magnet to supply the claimed output power of the system.

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4 See, e.g., page 18 lines 11-17.
5 See, e.g., page 17 lines 13-23.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 6,362,718. Although the conflicting claims are not identical, they are not patentably distinct from each other[6] because each describe, *inter alia*, a 'motionless electromagnetic generator' having one or multiple permanent magnets, input coils, output coils, and switching circuits performing the operation of 'generating output power'.

Claim Objections

Claim 1 is objected to because of the following informalities: at line 8 of claim 1, "first" should read --second--. Appropriate correction is required.

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6 Note generally that for method claims, under MPEP 2112.02, the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the

Claim Rejections - 35 USC § 112

Claims 1-14 are rejected under 35 U.S.C. § 112, 1st paragraph

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as **to enable** any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification. Correction is required.

Claims 1-14 are rejected under 35 U.S.C. § 112, 2nd paragraph,

> The specification shall conclude with one or more claims particularly pointing out and **distinctly claiming the** subject matter which the applicant regards as his **invention**.

Claims 1-14 are rejected under 35 U.S.C. § 112, second paragraph, for the reasons set forth in the objection to the specification and therefore it is not distinctly claimed how the invention is supposed to function. Further, specifically in claim 4, the usage of the phrase "**driving said switching and control circuit by said first portion of said flow of electrical current following said starting process**" is not understood. For purposes of examination the phrase has been taken to mean, as understood from the specification[7], that the system need not rely on input power after the starting process has occurred. However, as previously pointed out this would cause the system to fail since perpetual motion devices do not exist, and therefore this phrase is not understood. Correction is required.

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claimed process. In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986).

Drawings

The drawing(s) is(are) objected to under 37 CFR 1.83(a) because it(they) fail(s) to show an operable system as described in the specification. That is, when the input power source (e.g., 38) is taken away, the remaining circuit becomes inoperable. Further, all figures referring to a coefficient of performance, receiving more power out than power that was put in, etc., are inoperable as violating at least the first and second laws of thermodynamics. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Correction is required. To avoid a new matter rejection/objection, a filed amendment to pass the requirements of 35 U.S.C. 132, must not introduce new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which must be shown to be supported by the original disclosure is as follows: new laws of thermodynamics which successfully refute the existing first and second laws which would allow for greater energy output than input. Correction is required.

All amendments with regard to this issue must ***specifically*** (page, line numbers, etc.) be pointed out where the amendment was supported in the original application in the reply to this Office action to avoid a new matter objection/rejection.

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7 See, e.g., page 18 lines 11-14.

Specification

The disclosure is objected to because of the following informalities: page 2 was missing from the specification. Appropriate correction is required.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. This application is not directed toward generation, as can be best understood. A generator takes energy from one form and changes it to another. This application is seen as a transformer which relies on the concept of perpetual motion[8] for operation.

Allowable Subject Matter

No claims are allowable over the prior art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Riley whose telephone number is 703.305.3487 until the 28 January 2004 when the number will change to 571.272.2083. The Examiner can normally be reached Monday through Thursday from 7:30-6:00 p.m. Eastern Standard Time. The Examiner's Supervisor is Mike Sherry who can be reached at 703.308.1680. Any inquiry about a case's location, retrieval of a case, or receipt of an amendment into a case or information regarding sent correspondence to a case **should be directed to 2800's Customer Service Center** at 703.306.3329. Any papers to be sent by fax MUST BE sent to fax number 703.872.9306. Any inquiry of a general nature of this application should be **directed to the Group receptionist** whose telephone number is 703.308.1782.

Shawn Riley
Primary Examiner

8 Notwithstanding applicants' caution that the invention should not be considered as perpetual motion at page 19 lines 6-12, that is what the invention is seen as.